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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,045	05/01/2001	Philip Ted Kortum	8285/431	5221
757	7590	11/27/2007	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			BORISSOV, IGOR N	
ART UNIT		PAPER NUMBER		
3628				
MAIL DATE		DELIVERY MODE		
11/27/2007		PAPER		

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

NOV 27 2007

GROUP 3600

Application Number: 09/847,045
Filing Date: May 01, 2001
Appellant(s): KORTUM, PHILIP TED

Vincent J. Gnoffo
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09/27/2007 appealing from the Office action
mailed 07/06/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

"SBC global network DSL: Customer Self Install"; the Internet printout of SBC Global Network - Digital Subscriber Line (<http://web.archive.org>). August 2000.

"Using Your Gateway PC guide"; Guide/Instruction Manual. 1997.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-8, 10-16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the "SBC global network DSL: Customer Self Install" (Hereinafter Document) in view of Using Your Gateway PC guide (Hereinafter Guide).

The Document, which appears to be published on August, 2000, teaches customer self install descriptions for self installation of a digital subscriber line modem, and discloses a system for customer self installation DSL kit, comprising:

Independent Claims

As per claim 1,

a digital subscriber line modem (page 4; last paragraph);

at least one digital subscriber line filter (page 1; 3rd paragraph);

a computer-readable medium containing a computer-readable software code (page 9; 2nd paragraph).

Furthermore, Document teaches that a consumer orders said kit for his/her computer Operating System (OS), thereby indicating that the arriving kit already requires no selection of OS (page 5; 3rd paragraph; a Table).

However, Document does not specifically teach that said instruction manual (Owner's Guide) is included in the kit.

Guide, which appears to be published on 11-1997 (See page 2), teaches guiding instructions how to assemble various components of a computer system using various connectors, including Phone connector, Line In connector, video connector, power connector, serial port connector, Joystick/MIDI connector, USB connector, etc., wherein said computer system is purchased by a user and delivered to the user in a container box (indicates "kit" feature) containing said guide, the system unit and accessory box (page 15-36).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Document to include that an instruction manual which is similar to said Guide is included in the kit, said manual providing instructions to install all elements of the kit, as suggested in Guide, because it would advantageously allow to provide the customer with necessary diagram and descriptions of the successive installation steps, thereby simplify the installation process for the customer.

As per **claim 8**, Document teaches said system, comprising:

- a network card (page 4; last paragraph);
- a digital subscriber line modem (page 4; last paragraph);
- at least one digital subscriber line filter (page 1; 3rd paragraph);
- a computer-readable medium containing a computer-readable connection software code (page 9; 2nd paragraph).

Furthermore, Document teaches that said kit is available for following OS: DOS, Windows and Macintosh, thereby indicating that a subscriber is required to indicate/select his/her computer OS (page 5; 3rd paragraph; a Table).

However, Document does not specifically teach that said instruction manual (Owner's Guide) is included in the kit.

Guide, which appears to be published on 11-1997 (See page 2), teaches guiding instructions how to assemble various components of a computer system using various connectors, including Phone connector, Line In connector, video connector, power connector, serial port connector, Joystick/MIDI connector, USB connector, etc., wherein said computer system is purchased by a user and delivered to the user in a container box (indicates "kit" feature) containing said guide, the system unit and accessory box (page 15-36).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Document to include that an instruction manual which is similar to said Guide is included in the kit, said manual providing instructions to install all elements of the kit, as suggested in Guide, because it would advantageously allow to provide the customer with necessary diagram and descriptions of the successive installation steps, thereby simplify the installation process for the customer.

As per **claim 16**, Document teaches said system, comprising:

- a network card (page 4; last paragraph);
- a digital subscriber line modem (page 4; last paragraph);
- at least one digital subscriber line filter (page 1; 3rd paragraph);
- a computer-readable medium containing a computer-readable connection software code (page 9; 2nd paragraph).

Furthermore, Document teaches a consumer computer manufacturer's Owner's Guide and computer's Operating System on installation media (CD or diskettes) (page 9; 2nd paragraph); and instruction regarding internet service provider software (page 3, 2nd and 3rd paragraphs).

Furthermore, Document teaches that said kit is available for following OS: DOS, Windows and Macintosh, thereby indicating that a subscriber is required to indicate/select his/her computer OS (page 5; 3rd paragraph; a Table).

However, Document does not specifically teach that said instruction manual (Owner's Guide) is included in the kit.

Guide, which appears to be published on 11-1997 (See page 2), teaches guiding instructions how to assemble various components of a computer system using various connectors, including Phone connector, Line In connector, video connector, power connector, serial port connector, Joystick/MIDI connector, USB connector, etc., wherein said computer system is purchased by a user and delivered to the user in a container box (indicates "kit" feature) containing said guide, the system unit and accessory box (page 15-36).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Document to include that an instruction manual which is similar to said Guide is included in the kit, said manual providing instructions to install all elements of the kit, as suggested in Guide, because it would advantageously allow to provide the customer with necessary diagram and descriptions of the successive installation steps, thereby simplify the installation process for the customer.

Dependent Claims

As per **claims 3-4, 10-11 and 18-19**, Guide teaches the container box, which contains the system unit and accessory box (page 15). The motivation to combine the references would be to advantageously protect the contents of the kit from being damaged or lost during shipment.

As per **claims 5 and 13**, said kit, wherein the instruction manual provides a point of contact telephone number associated with said kid; said kid including the digital subscriber line modem (page 3, 6th paragraph; page 5, 6th paragraph; page 4; last paragraph).

As per **claims 6 and 14**, said kit, wherein the instruction manual provides a point of contact telephone number associated with said kid; said kid including the digital line filter (page 3, 6th paragraph; page 5, 6th paragraph; page 1, 3rd paragraph).

As per **claims 7, 15 and 20**, said kit, wherein the instruction manual provides a point of contact telephone number associated with said kid; said kid including the description of computer-readable connection software code (page 9; 2nd paragraph).

(10) Response to Argument

Applicant argues that the prior art of record fails to disclose or suggest "at most one instruction manual which describes a unified installation process which provides instructions to install all of the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code".

In response to this argument the examiner maintains that Guide was applied for this feature. Specifically, Guide teaches a booklet including guiding instructions how to assemble various components of a computer system comprising a modem using various connectors, including Phone connector, Line In connector, power connector, serial port connector, USB connector, etc. Guide and the computer system are delivered to a purchaser of the computer system together, inside a container box. While Guide does not specifically refer to DSL modem, it does provide detailed instructions of how to connect various parts of an electronic system, and, therefore, it would have been obvious to include an instruction manual which is similar to said Guide in the Document DSL kit for the benefit of helping the customer with necessary diagram and descriptions

of the successive installation steps, thereby simplify the installation process for the customer.

To this end the examiner points out that at the time the invention was made it was common practice to include instruction manuals with purchases even simple mechanical or electrical devices, such as a desk lamp. Instruction manuals describe the purpose of each part and provide diagrams of proper connection of parts, thereby helping customers with assembling of purchased goods. And this is what Guide does: provides a list of all parts included in the kit, provides a user with a detailed instruction of how to assemble the components of the computer system, provides clear pictures and diagrams of various parts and connecting steps. Finally, Guide provides help with troubleshooting and lists contact information for technical support and warranty issues.

DSL kit is more complicated product than the desk lamp, and may require more effort from the customer to assemble it properly, including certain knowledge about computers in general. Therefore, it would be obvious that any DSL kit supplier or manufacturer would include an instruction manual which is similar to said Guide to help the customers with installation process, and to provide them with contact information for questions and support.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Igor Borissov



IGOR N. BORISSOV
PRIMARY EXAMINER

Conferees:

John W. Hayes



Vincent Millin

